UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,868	12/04/2003	Paul H. Norton	8567-592U2 (P-0275)	7880

570 7590 05/03/2007

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER	
GRAY, PHILLIP A	

ART UNIT	PAPER NUMBER
3767	

MAIL DATE	DELIVERY MODE
05/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/727,868	NORTON ET AL.	
	Examiner	Art Unit	
	Phillip Gray	3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/9/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to applicant's communication of 2/9/2007. Currently claims 1-14 are pending and rejected below.

Response to Arguments

Applicant's arguments filed 2/9/2007 have been fully considered but they are not persuasive.

Applicant argues that the claim limitation of a sliding joint where "the first open axial end being adapted to engage with an enlarged, blunt mounting end of a syringe needle, the second axial end of the sliding joint further being adapted to releasably engage at least a releasable needle receiver on a distal end of a barrel of a conventional syringe without needle, the syringe being releasably removable from the sliding joint after fluid coupling with the vial through the passageway of the sliding joint without removal of the sliding joint from the tubular connector and without the needle" overcomes the prior art of record, namely Neftel.

It is examiners position that the claim limitation above does not overcome Neftel, and is fully disclosed by Neftel. Examiner draws applicant's attention to figures 3 and 4 of Neftel. Examiner references a vial (10), and syringe 12, a tubular connector (14) and a sliding joint (66). It is examiners position that this sliding joint has an axial end "adapted to engage a blunt mounting end of a syringe needle" (60), and another axial end "adapted to" releasably engage a needle receiver on a distal end of a barrel of a conventional syringe without a needle (12), and this syringe would be removable from

the sliding joint and without removal of the sliding joint (66) from the tubular member (14). During examination, claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969). When given the broadest reasonable reading the claims, as currently written, do not overcome the prior art of record, as pointed out above.

The elements disclosed in Neftel are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made and proper. See rejection discussion below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Neftel et al. (U.S. Patent Number 5,827,262). Neftel discloses a syringe device for mixing two compounds (see figures 1-18b, specifically 12-18b). Neftel discloses a syringe (12), sealed vial (10) safety device forming a fluid coupling (14) between, a sliding joint (see element at 218 or 66), and a pointed end/blunt needle (34). Further the tubular connector (14) has an open-ended cavity (210), adapted to receive a flange (18) of a vial (10) with stopper, and at least one non-releasable spring clip

member (element near 212) which snaps against the vial when it is cammed under and past the spring clip (see figure 12).

The Neftel syringe device is fully capable of satisfying all functional, structural, and spatial claim language limitations. The Neftel device has a sliding joint fully capable of being adapted to releasably engage at least a releasable needle receiver on a distal end from the sliding join after fluid coupling with the vial through the passageway of the sliding joint without removal of the sliding joint from the tubular connector and without the needle. The needle of Neftel can be non-releasably captured in the tubular connector with the sliding joint, and the sliding joint and needle receiver is configured to releasably mate with the blunt mounting end of the enclosed needle, along with the needle mount (see paragraphs at columns 4-17)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neftel. Neftel discloses the claimed invention except for packaging together in a sealed sterile packaging. It would have been obvious to one having ordinary skill in the art at the time the invention was made to packaging the components together in a sealed sterile packaging since it was known in the art that most medical syringes and components are kept from being contaminated and free from bacteria or other microorganisms by wrapping in sealed sterile packaging like plastic or polymer wrap.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PAG

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER